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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/501,408	02/10/2000	Frederic Serre	A32979-070337.0181	3806

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EXAMINER

SHOSHO, CALLIE E

ART UNIT

PAPER NUMBER

1714

DATE MAILED: 04/09/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

09/501,408

Applicant(s)

SERRE, FREDERIC

Examiner

Callie E. Shosho

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 18 March 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 18 March 2003. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
  - (b) ☒ they raise the issue of new matter (see Note below);
  - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
  - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: see attachment.

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: \_\_\_\_\_.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: None.

Claim(s) objected to: None.

Claim(s) rejected: 14-22.

Claim(s) withdrawn from consideration: None.


8. ☐ The proposed drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.
10. ☐ Other: \_\_\_\_\_

**Attachment to Advisory Action**

1. Applicant's amendment filed 3/18/03 has been fully considered but it has not been entered given that the amendment raises new issues that would require further consideration. Also, the amendment raises new issues under 35 USC 112, first paragraph and second paragraph.

(a) Claim 1 has been amended to recite that the blend of carbon black and white filler is present in amount of "greater than or equal to 15 phr and less than 50 phr". It is the examiner's position that this change fails to satisfy the written description requirement under 35 USC 112, first paragraph since there does not appear to be a written description requirement for the upper limit of the blend of carbon black and white filler in an amount of "less than 50 phr" in the application as originally filed, *In re Wright*, 866 F.2d 422, 9 USPQ2d 1649 (Fed. Cir. 1989) and MPEP 2163. Applicant has not pointed to any portion of the specification, and examiner has not found any support for this phraseology in the specification as originally filed.

It is noted that the recitation of "less than 50 phr" includes any value less than 50 phr such as 20 phr, 33 phr, 42 phr, 48 phr, etc. for which there is no support in the specification as originally filed. While there is support in the specification for the upper limit of the blend of carbon black and white filler of 50 phr or 45 phr (page 6, second full paragraph) or 30 phr, 35 phr, or 40 phr (examples), there is no support for the recitation of "less than 50 phr", which includes any value less than 50 phr, as the upper limit of amount of the blend of carbon black and white filler as recited in the above phrase.



(b) Claim 1 has also been amended to recite that “the reinforcing filler is present in an amount of less than 50 phr”. It is the examiner’s position that this change fails to satisfy the written description requirement under 35 USC 112, first paragraph since there does not appear to be a written description requirement for reinforcing filler in an amount of “less than 50 phr” in the application as originally filed, *In re Wright*, 866 F.2d 422, 9 USPQ2d 1649 (Fed. Cir. 1989) and MPEP 2163. Applicant has not pointed to any portion of the specification, and examiner has not found any support for this phraseology in the specification as originally filed.

It is noted that the reinforcing filler is either white filler or a blend of carbon black and white filler. With respect to the use of white filler alone, it is noted that the recitation of “less than 50 phr” includes any value less than 50 phr such as 5 phr, 10 phr, 41 phr, 48 phr, etc. for which there is no support in the specification as originally filed. While there is support in the specification for the recitation that the white filler is present in amounts of between 15 and 40 phr and 20 to 35 phr, there is no support for the recitation that the white filler is present in any amount less than 50 phr.

Similarly, with respect to the blend of carbon black and white filler, there is no support for the recitation that the blend is present in an amount of “less than 50 phr” for the reasons set forth in paragraph (a) above.

(c) As noted in paragraph (b) above, claim 1 has also been amended to recite that “the reinforcing filler is present in an amount of less than 50 phr” and the claim also recites that the white filler is present in an amount of “between 15 phr and 40 phr” and the filler blend is present

in an amount of “greater than or equal to 15 phr and less than 50 phr”. The scope of the claim is confusing because the recitation that the reinforcing filler is present in amounts of “less than 50 phr” includes amounts such as 5 phr, 10 phr, etc which fall outside the other recitations regarding the amounts of white filler or blend of carbon black and white filler.

Further, it is noted that a broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by “such as” and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim recites the broad recitation that the reinforcing filler is present in an amount of “less than 50 phr”, and the claim also recites that the white filler (which is a type of reinforcing filler) is present in an amount of “between 15 and 40 phr” or that the blend of carbon black and white filler is present in an amount of “greater than or equal to 15 phr and less than 50 phr” which are the narrower statements of the range/limitation.

(d) It is noted that even if the amendment were entered, the claims would not be allowable over the prior art of record for the following reasons.

First with respect to the use of white filler alone, it is noted that the present claims require the use of between 15 phr and 40 phr white filler and also that the filler is present in an amount of less than 50 phr while JP 09302146 discloses the use of white filler, i.e. silica, in an amount of 20-150 phr. Applicant argues that the composition of JP 09302146 requires high amounts of filler while the present invention uses comparatively low amounts of filler. Applicant also correctly notes that all the examples utilize silica in amount outside that presently claimed.

However, these examples are just a few preferred embodiments of JP 09302146. It is noted that “applicant must look to the whole reference for what it teaches. Applicant cannot merely rely on the examples and argue that the reference did not teach others.” *In re Courtright*, 377 F.2d 647, 153 USPQ 735,739 (CCPA 1967). Further, “nonpreferred disclosures can be used. A nonpreferred portion of a reference disclosure is just as significant as the preferred portion in assessing the patentability of claims.” *In re Nehrenberg*, 280 F.2d 161, 126 USPQ 383 (CCPA 1960).

A fair reading of the reference as a whole discloses that the composition comprises 20-150 parts silica that almost completely overlaps the amount of silica presently claimed. Attention is drawn to MPEP 21313.03 which states that “if the claims are directed to a narrow range, the reference teaches a broad range, and there is evidence of unexpected results within the claimed narrow range, depending on the other facts of the case, it may be reasonable to conclude that the narrow range is not disclosed with “sufficient specificity” to constitute an anticipation of the claims.” It is the examiner’s position that JP 09302146 does disclose the claimed range with

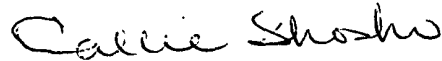
“sufficient specificity”. While the claimed range is narrower than the broad range disclosed in JP 09302146, applicants have provided no evidence of unexpected or surprising results within the claimed narrow range.

With respect to the reinforcing filler which is a blend of carbon black and white filler, applicants argue that JP 09302416 discloses the use of 50-150 phr carbon black and silica which falls outside the scope of the present claims which require an amount of “greater than or equal to 15 phr and less than 50 phr” and also that the filler is present in an amount of less than 50 phr.

While it is agreed that in light of the amendment JP 09302146 would no longer be applicable against claim 14 as a reference under 35 USC 102, it is the examiner’s position that the reference would be applicable under 35 USC 103. While JP 09302146 discloses the use of 50 phr carbon black and silica and the present claims would require the use of less than 50 phr carbon black and silica, the instantly claimed amount of carbon black and silica and that taught by JP 09302146 are so close to each other that the fact pattern would be similar to the one in *In re Woodruff*, 919 F.2d 1575, USPQ2d 1934 (Fed. Cir. 1990) or *Titanium Metals Corp. of America v. Banner*, 778 F.2d 775, 227 USPQ 773 (Fed.Cir. 1985) where despite a “slight” difference in the ranges the court held that such a difference did not “render the claims patentable” or, alternatively, that “a prima facie case of obviousness exists where the claimed ranges and prior art ranges do not overlap but are close enough so that one skilled in the art would have expected them to have the same properties”. In light of the case law and given that there is only a “slight” difference between the amount of carbon black and silica disclosed by JP 09302146 and the amount disclosed in the present claims, it would have been obvious to one of

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ordinary skill in the art that the amount of carbon black and silica disclosed in the present claims is but an obvious variant of that disclosed in JP 09302146.



Callie E. Shosho  
Examiner  
Art Unit 1714

CS  
April 7, 2003